



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

09/910,768

07/24/2001

Kenkou Yamaura

31721-174066

3574

7590

10/18/2006

VENABLE, BAETJER, HOWARD & CIVILETTI, LLP

P.O. Box 34385

Washington, DC 20043-9998

EXAMINER

BOVEJA, NAMRATA

ART UNIT

PAPER NUMBER

3622

DATE MAILED: 10/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	09/910,768	YAMAURA, KENKOU	
	Examiner	Art Unit	
	Namrata Boveja	3622	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 22 June 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 5-7 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 5-7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 July 2001 and 04 February 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### DETAILED ACTION

1. This office action is in response to communication filed on 06/22/2006.
2. Claims 5-7 are presented for examination.
3. Amendments to claims 5-7 and to Figure 7 have been entered and considered.
4. Typographical error made in the rejection for claims 38 and 47 has been

#### **Claim Rejections - 35 USC § 112**

5. *The second paragraph of 35 U.S.C. 112 is directed to requirements for the claims:*

*The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.*

*There are two separate requirements set forth in this paragraph:*

*(A) the claims must set forth the subject matter that applicants regard as their invention; and*

*(B) the claims must particularly point out and distinctly define the metes and bounds of the subject matter that will be protected by the patent grant.*

*Claim 5 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, the claim **preamble** recites sending a mail from the first person to the second person, from the second person to the third person, and "so on." The scope of this statement is unclear, since it is not apparent if you stop after the fourth person or the fifth person, etc. Additionally, it is unclear what is meant by "a **former recipient**" in **step (a)**. Specifically, it is not clear if the former recipient refers to the recipient of this e-mail or a recipient of a different e-mail that was sent before. Furthermore, the claim recites **determining whether the recipient is on a mailing list** in **step (c)**, and then **sending the e-mail to an e-mail address of an e-mail recipient** in **step (d)**, and therefore the e-mail is sent to anybody and has nothing to do with*

Art Unit: 3622

*whether the recipient was or was not found in step (c). These steps do not add up to a chain mailing case, since as stated by (d), the e-mail goes to any recipient and not necessarily to a recipient on the mailing list that was being identified in (c).*

6. *The following is a quotation of the first paragraph of 35 U.S.C. 112:*

*The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.*

*Claim 6 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Specifically, the claim introduces the limitation "the user is prompted to change outgoing mail server settings of the user's e-mail client program to a server device address," and this constitutes new matter, as this claim limitation is not supported by the specification. While the specification states to make changes to the outgoing mail server settings, it does not specifically state that the user is prompted to make these changes to the server settings.*

**Claim Rejections - 35 USC § 103**

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. *Claims 5 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sugimoto Hideo et al. (Patent Number JP 11-242714 hereinafter Hideo) in view of Creswell et al. (Patent Number 6,564,264 hereinafter Creswell).*

**Disclaimer:** *Claim 5 was found to be deficient under U.S.C. 112 second. To the extent the claimed invention was understood, the following art was applied.*

In reference to claim 5, Hideo teaches a homepage access system, *for a chain mailing case where a mail is sent from a first person to a second person, and from the second person to a third person, and so on, (this part of the preamble is considered to be an intended use, since no step is recited in the claim to make this association of a chain mailing case, it is not given any weight)* using lottery numbered e-mails (i.e. greeting cards with lottery numbers), said system being used for accessing a server device having a homepage for providing a mail sending/receiving service to a terminal device over a network, said server device comprising: (a) means for starting up a mailer of said server device by said terminal device accessing said homepage and a sender *or a former recipient* clicking on a predetermined button on said homepage (page 16, paragraph 1, lines 1-18, and Figure 2); (b) means for instructing that the sender *or a former recipient* will create an e-mail by the start up of said mailer (page 16, paragraph 1-3, lines 1-41, and Figures 2 and 3); (c) means for determining the suitability of the e-mail upon completion of creating the e-mail (Figure 11, item 806 and associated text: a card cannot be sent to and from a same address and page 23, paragraph 2, lines 1-11); (d) means for writing at the end of the e-mail a lottery number (Figure 17 items (c) and (e) *which demonstrates a message addressed to the recipient's e-mail address that also*

*includes a prize lottery number 0400599860 as part of the e-mail message that was sent to the recipient identified in (c) as Hanako Tanaka, t-denno@hakuhold.co.jp), and an address of said homepage (Figure 2 item (i) that recites a webpage address for accessing the sent greeting card and accompanying lottery number), and further attaching a notification of a drawing thereto and sending the e-mail to an e-mail address of the an e-mail recipient (Figure 7 lines 6-9 that gives notification of when the prize lottery will be held and when the results can be known), in the event that said determining means determines the e-mail to be suitable; (e) means for saving said lottery number and said e-mail address of the e-mail recipient to a file within the server device at the time of sending the e-mail to the e-mail recipient (page 19, paragraph 4, lines 3-10 and Figures 3 and 15 which illustrate that the information to be stored in server system prize lottery database includes entrance ID number or the prize lottery number and the recipient's e-mail address); (f) means for performing processing for randomly determining a winning lottery number from said saved lottery numbers (page 21 paragraph 2, lines 8-10 where the server randomly determines a winning lottery number to determine winners of premiums, where the premiums are simply the prizes of the underlying lottery program); and (g) means for matching an e-mail address input by said e-mail recipient with the lottery number and e-mail address of said e-mail recipient saved in said file, in the event that said e-mail recipient accesses the address of said homepage written in the sent e-mail and checks winning of the lottery number, so as to check the identification of a winner (page 20, paragraph 14, lines 1 to page 21, paragraph 15 lines 10 and Figures 5 and 14 where it is recited that the server creates a*

personal web page after it determines the e-mail address and password (or other specific ID) of the sender or the receiver and displays whether the sender and receiver have won or lost the lottery for premiums by having identified the winner's identity through the e-mail address and password information previously).

*Hideo is silent about checking to determine whether the recipient is on a mailing list. Creswell teaches checking to determine whether the recipient is on a mailing list (col. 5 lines 11-30). It would have been obvious to a person of ordinary skill in the art at the time of the applicant's invention to include the feature of checking to determine whether the recipient is on a mailing list to improve the user's communication efficiency by relieving the user of the burden for verifying which user is on a mailing list and to detect any errors made in the address composed by the user.*

8. In reference to claim 7, Hideo teaches a homepage access system using lottery numbered e-mails, wherein said server device has an original mailer set so as to be capable of accessing said homepage for sending/receiving e-mails, said server device comprising: means for displaying a mailer download screen upon a receiving terminal device to access an original mailer download request, instructing input of required items, and registering the necessary items in a user registration file upon completion of input of the required items, and downloading said original mailer (page 13 , paragraph 6, line 1 to page 15 paragraph 4 line 20 and Figure 1).

9. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hideo in view of Official Notice.

**Disclaimer:** Claim 6 was found to be deficient under U.S.C. 112 first. To the

*extent the claimed invention was understood, the following art was applied.*

In reference to claim 6, Hideo explicitly or at least implicitly discloses wherein, upon a user registration request from said terminal device, said server device displays a user registration screen and instructs input of required items, and wherein, upon the user making input according to said instructions, said required items are stored in a user registration file (see at least Figures 1-5 and associated text).

As to "the user of said registration request is provided with a nickname, and the user of said registration request is notified of the nickname," Hideo does not specifically disclose these steps. However, Official Notice is taken that these steps are well known and practiced in case a nickname is desired to be used. It would have been obvious to one skilled in the art at the time the invention was made to add the above well-practiced steps to Hideo to implement the process as is ordinarily done in case a nickname is desired to be used.

*As to "the user is prompted to change outgoing mail server settings of the user's e-mail client program to a service device address," Hideo does not specifically disclose these steps. However, Official Notice is taken that these steps are well known and practiced in case a company with multiple servers in different geographical locations is trying to increase the speed of e-mail transmittal and delivery, and is able to do so by selecting a different server. It would have been obvious to one skilled in the art at the time the invention was made to add the above well-practiced steps to Hideo to implement the process as is ordinarily done in case speed efficiency for both transmittal and delivery is desired by the sender.*



**Response to Arguments**

10. After careful review of Applicant's remarks/arguments filed on 01/24/2006, the Applicant's arguments with respect to claims 1-30 are presented for examination and have been fully considered but are moot in view of the new ground(s) of rejection.

Amendments to the drawings and claims have been entered and considered.

11. The previously made rejection under 35 USC § 112 has been removed in view of the amendment by Applicant, however two new 35 USC § 112 rejections have been made due as necessitated by applicant amendments.

12. In reference to claim 5, Applicant argues that the claimed invention sends the verified e-mail directly to the recipient with a lottery number attached to it and that Hideo only sends a notice to the recipient that a greeting card is being kept for the. The Examiner respectfully disagrees with the Applicant for the following reason.

Specifically, Figure 17 items (c) and (e) demonstrates a message addressed to the recipient's e-mail address that also includes a prize lottery number 0400599860 as part of the e-mail message that was sent to the recipient identified in (c) as Hanako Tanaka, t-denno@hakuhodo.co.jp.

13. Applicants additional remarks are addressed to new limitations in the claims and have been addressed in the rejection necessitated by the amendments.

14. Claims 6 and 7 both depend from claim 5, and they are not patentable for the same reasons, as well as for reciting additional features and limitations.

**Conclusion**

15. Applicant's amendment necessitated the new ground(s) of rejection presented in

this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

**Point of Contact**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Namrata (Pinky) Boveja whose telephone number is 571-272-8105. The examiner can normally be reached on Mon-Fri, 8:30 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, Eric Stamber can be reached on 571-272-6724. The **Central Fax Number** for the organization where this application or proceeding is assigned is **571-273-8300**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.

Art Unit: 3622

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should


you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 1866-217-9197 (toll-free).



NB

September 23<sup>rd</sup>, 2006



**RETTA YEHDEGA**  
**PRIMARY EXAMINER**